

REMARKS AND ARGUMENTS

Amendments to the Claims

Claims 1-7 are canceled to eliminate the objections under 37 CFR 1.75 as being a substantial duplicate.

Claims 15 and 20 are amended for clarification to overcome the rejections under 35 USC§ 112.

Claim Rejections – 35 USC §112

The Examiner rejected claims 15 and 20 as being indefinite. Applicants have herein amended claims 15 and 20 to obviate this rejection.

Claim Rejections –35 USC §102(b)

Examiner rejected Claims 1, 7-8, 16-17 and 21 under 35 USC §102(b) as being anticipated by Kuok et al. (US6,790,464 B2). Claims 1-7 have been canceled as mentioned above. As for Claims 8, 16, 17, and 21, Applicants traverse the rejections as set forth below.

The present application discloses a composition used for prophylaxis and treatment of osteoporosis which is completely different than that of the prior art reference US 6,790,464 B2 used for prevention or treatment of prostate disorders and prostatic carcinoma. Since osteoporosis and prostate disorders symptoms are undoubtedly irrelevant to one another, the present invention should be considered as novel compared to the prior art reference US 6,790,464 B2. In any event, Kuok et al. does not teach or suggest a mixed extract of Fructus cnidii and Semen cuscutae in an amount sufficient to treat osteoporosis. Therefore, the independent Claims 8 and 17 together with the claims 16 and 21 dependent thereon should be in the condition for allowance.

Claim Rejections –35 USC §103(a)

Regarding the obligation under 37 CFR 1.56, Applicant confirms that each claim in the present application is commonly owned by the listed joint inventors.

Examiner rejected Claims 1-13, 16-18 and 21 under 35 USC §103(a) as being unpatentable over Kuok et al. (US 6,790,464 B2). As mentioned above, Claims 1-7 have been canceled. As to Claims 8-13, 16-18, and 21, Applicant traverses the rejections as set forth below.

As aforementioned, the present invention distinguishes from the prior art reference US6,790,464 B2 in that the former is for the treatment of osteoporosis but the latter is for the treatment of prostate disorders or prostatic carcinoma. It is known by persons of ordinary skill in the art that, a pharmaceutical composition should be defined by a

composition together with the disease it treats. A definition only including a composition would be considered as a normal chemical composition due to absence of pharmaceutical effects. Therefore, when a pharmaceutical composition is claimed, a composition and its related diseases should be inseparably considered.

In addition, the connection between a composition and a disease in a pharmaceutical composition should be supported by sufficient experiments, so as to convince persons of ordinary skill in the art of the truth that the composition works on the disease. For this reason, Kuok et al. (the prior art reference US 6,790,464 B2) shows several experiments in order to verify the curative effects on prostate disorders or prostatic carcinoma. However, please note Kuok et al. fail to show anything about osteoporosis or the connection between the composition and osteoporosis. How could it be inferred as obvious by arbitrarily applying the composition to prophylaxis without any supported experiments? It cannot. Therefore, in view of the prior art reference, persons of ordinary skill in the art would not be able to expect the curative effects of osteoporosis by the composition. Furthermore, Kuok et al. is non-analogous art and thus is an improper 35 U.S.C. 103 reference.

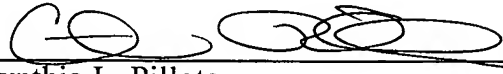
In contrast, the present invention explicitly discloses the pharmaceutical mechanism and effect test examples of the composition specifically applied to osteoporosis as set forth in the specification (see paragraphs [0022], [0037] to [0054]). Furthermore, the claims specifically recite that the extract of Fructus cnidii and Semen cuscutae are present in an amount sufficient to treat osteoporosis. Therefore, the independent Claims 8 and 17 together with all the dependent Claims 9-16 and 18-21 thereof should be allowable.

CONCLUSION

In view of the above remarks, it is believed that all the pending claims are clearly patentable over the prior art references relied on by the Examiner. In view of this, Applicant respectfully requests that a timely Notice of Allowance be issued to this application.

Respectfully submitted,

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